

PATENT
Docket No. 300622004600

1652
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Rajesh S. GOKHALE, et al.

Serial No.: 09/500,747

Filing Date: 9 February 2000

For: METHODS TO MEDIATE
POLYKETIDE SYNTHASE MODULE
EFFECTIVENESS

Examiner: K. Kerr

Group Art Unit: 1652

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to a Office Action herein mailed 11 June 2001, time for response to which is set to expire 11 July 2001.

Restriction Requirement

The Examiner is requiring restriction under 35 U.S.C. §121 to one of the following inventions:

- I. Claims 1-5, drawn to methods of making polyketide synthases (PKSs);
- II. Claims 6-18, drawn to PKSs;
- III. Claims 19-21, drawn to methods of making polyketides; and
- IV. Claim 22, drawn to polyketides.

Applicant respectfully traverses the Restriction and submits that the asserted basis for the Restriction are insufficient. Applicant thus requests the Restriction be reviewed and modified for the following reasons.

The Examiner has stated that Group I (claims 1-5) and Group II (claims 6-18) “are related as process of making and product made” but are “patentably distinct.” Applicant respectfully traverses based on the following.

Applicant notes that both Groups have been classified by the Examiner as belonging to class 435, subclass 183. Thus regardless of the correctness of the above position, Applicant respectfully points out that there is no search burden present because the search of Group I would be identical to the search of Group II and vice versa. In addition, Applicant believes that claims 1-5 are related to claims 6-18 as a subcombination is related to a combination. Standards for such a relationship are set forth at MPEP 806.05 through 806.05(c). Therefore, because no burden of search is present in searching a single subclass (in contrast to the requirement for a “serious burden” at MPEP 803), and the “subcombination-combination” relationship exists between the two groups, the reasons for restriction between these Groups are insufficient and the restriction may be properly withdrawn.

The Examiner has stated that Group I (claims 1-5) and Group III (claims 19-21) are “related by virtue of the common PKS” but are “patentably distinct.” Applicant respectfully traverses based on the following.

Applicant notes that both Groups have been classified by the Examiner as belonging to class 435, though to different subclasses. Applicant believes that there is no “serious burden” as set forth at MPEP 803 in searching a different subclass in the same class. In addition, Applicant believes that claims 19-21 (Group III) are related to claims 6-18 (Group II) as a combination is related to a subcombination, and claims 6-18 (Group II) and claims 1-5 (Group I) are a combination-subcombination as set forth above. Standards for such a relationship are set forth at MPEP 806.05 through 806.05(c). Therefore, because no “serious” burden of search is present in searching a different subclass within the same class, and the “subcombination-combination” relationship exists between Groups III and II, and II and I, the reasons for restriction between these Groups are insufficient and the restriction may be properly withdrawn.

The Examiner has stated that Group IV (claim 22), is “patentably distinct” from Groups I, II, and III. Applicant respectfully traverses based on the following.

Applicant believes that claim 22 is related to claims 19-21, as a combination is related to a subcombination. Therefore, because the “subcombination-combination” relationship exists between Groups III, II, and I as noted above, the reasons for restriction between Group IV and these Groups are insufficient and the restriction may be properly withdrawn.

In the event that the instant Restriction Requirement is maintained despite the above discussion, Applicant hereby elects Group I, claims 1-5, with traverse for the reasons presented above.

Applicant expressly reserves the right under 35 U.S.C. §121 to file a divisional application directed to the non-elected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicant requests examination of the elected subject matter on the merits.

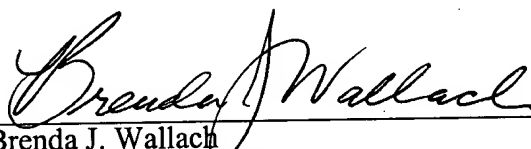
If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (858) 720-7961.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 300622004600. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: July 11, 2001

By:


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